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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,438	03/29/2001	J. Guy Breitenbucher	ORT-1396	5665

27777 7590 06/11/2003
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EXAMINER

LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/11/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/820,438	Applicant(s) BREITENBUCHER ET AL.	
	Examiner Hong Liu	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on 06 May 2003.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-22 is/are rejected.

7) ☒ Claim(s) 3-7 and 17 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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DETAILED ACTION

Claims 1-22 are pending in this application.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 6, 2003 has been entered.

Claim Rejections - 35 USC § 112

Claims 1, 18, 19, and 22 are indefinite in that the metes and bounds of “ester” and “amide” are unknown. There is no definition for these terms in the specification that warrant applicants' explanation that these terms refer to pharmaceutically acceptable masking groups or protecting groups.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 8, 10, 12-16, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Joshi et al., Chem Abstract 105: 190834. The instantly claimed compounds read on the reference compound. See the enclosed copy of CAPLUS computer search report and the compounds having RN 104815-95-4, 104843-80-3, 104815-92-1, 104815-93-2, 104815-94-3.

Claims 1, 2, 8, 10, 12, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Buu-Hoi et al., Chem Abstract 68: 114411. The instantly claimed compounds read on the reference compound. See the enclosed copy of CAPLUS computer search report and the compounds having RN 18121-71-6.

Claims 1, 2, 8, 10-12, 14-16, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Suh et al., Chem Abstract 69: 77112. The instantly claimed compounds read on the reference compound. See the enclosed copy of CAPLUS computer search report and the compounds having RN 1969-79-5.

Claim Rejections - 35 USC § 103

Claims 1, 2, 8-16, 20, and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Neuenschwander et al. (US 5,385,912). Applicants' arguments have been fully considered but not found persuasive. Although applicants amended the claims to exclude the species of bridged bicyclic rings for the definition of Z, the definition of "A" in the reference is

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not limited to bridged bicyclic rings. "A" can be imidazole, piperidine, piperazine, etc.(see cols. 2-3). Therefore, the instantly claimed compounds still fall within the genus of the reference compounds.

Claims 1, 2, 8-16, 20, and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Connor (WO 98/06703). Applicants' arguments have been fully considered. Even though R7 of the reference compounds requires a spacer, the substitution on the phenyl, - $(CH_2)_{0-3}$ -NR6R7, corresponds to such a construct of the instantly claimed compounds, -R9-Z, in which R9 is defined to be an alkylene, Z can be NR11R12 where each of R11 and R12 is selected from H, alkyl, etc. R6 of the reference is defined to be H and alkyl, and R7 is defined to be $(CH_2)_n$ NR10R11, which is a substituted alkyl. According to the definition of "alkyl" in the present invention, "alkyl" should be understood to include substituted alkyl (see page 7). Therefore, the instantly claimed compounds still fall within the genus of the reference compounds.

Claim Objections

Claims 3-7 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art of record nor a search in the pertinent art area teaches the compounds where R³ is as defined in Claims 3-7 and 17.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday

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through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
June 9, 2003

Mukund J. Shah
Mukund Shah
Supervisory Patent Examiner
Art Unit 1624